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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,546	04/11/2001	Ralph A. Mosher	D/A0584	4763

7590 07/28/2006

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Rochester, NY 14644

EXAMINER
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DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/833,546

Applicant(s)

MOSHER ET AL.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1,3,4 and 6-25 is/are pending in the application.
- 4a) Of the above claim(s) 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 05-22-06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

The 102 and 103 rejections are withdrawn due to Applicant's amendments. The IDS is acknowledged.

#### ***Election/Restrictions***

This application is in condition for allowance except for the presence of claim 26 directed to an invention non-elected with traverse in the reply filed on 12-18-02. Applicant is given ONE MONTH or THIRTY DAYS from the date of this letter, whichever is longer, to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above and below matters.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-4, and 6-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,602,156 to Schlueter, Jr. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are to an endless seamed flexible belt comprising a substrate and a seam comprising alcohol-soluble polyamide, whereas the Schlueter reference claims a endless seamed flexible belt comprising a polyimide substrate and alcohol-soluble polyamide and a seam comprising alcohol-soluble polyamide adhesive. See patented claim 1 to the structure as in instant claim 3 and patented claim 21. Therefore the present claims are broader in scope and encompasses that which is claimed by the Schlueter, Jr. reference.

Claims 1, 3-4, and 6-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-17 of U.S. Patent No. 5,997,974 to Schlueter, Jr. in view of U.S. Patent No. 6,602,156 to Schlueter, Jr. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are to an endless seamed flexible belt comprising a substrate and a seam comprising alcohol-soluble polyamide, whereas the Schlueter '974 reference claims a endless seamed flexible belt comprising a substrate and a seam comprising a conductive bonding material in the gap of the seam. The meaning of conductive bonding material is defined at col. 6, lines 9-22 and col. 12, lines 3-20 and is an adhesive filled in the gap comprising polyamide adhesive.

While Schlueter '974 does not state the polyamide adhesive is alcohol soluble, Schlueter '156 reference claims a endless seamed flexible belt comprising a polyimide substrate and

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alcohol-soluble polyamide seam comprising alcohol-soluble polyamide adhesive. See patented claim 1 to the structure as in instant claim 3 and patented claim 21 (Schlueter '156). Thus, it would have been obvious to one having ordinary skill in the art to have modified the conductive bonding material of Schlueter '974 to use the alcohol soluble adhesive of Schlueter '156 because Schlueter '156 claims the exact same alcohol-soluble polyamide adhesive structure used in the seam of a belt providing electrostatic transfer of toner (col. 9, lines 30-40, patented claim 1 and patented claim 21 of Schlueter '156). Therefore the present claims are broader in scope and encompasses that which is claimed by the Schlueter, Jr. references.

Claims 1, 3-4, and 6-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,4, 6, 8-11, 13-18 and 21-25 of copending Application No. 10/014,452. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are to an endless seamed flexible belt comprising a substrate and a seam comprising alcohol-soluble polyamide, whereas the instant application '452 claims a endless seamed flexible belt comprising a polyimide substrate and alcohol-soluble polyamide and a seam comprising alcohol-soluble polyamide. See patented claim 10 to the exact same alcohol-soluble polyamide structure. Therefore the present claims are broader in scope and encompasses that which is claimed by the '452 application

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Allowable Subject Matter***

Claims 1, 3-4, and 6-25 are in condition for allowance except for the sustained Obvious Double Patenting rejections recited above. As previously set forth, the applied prior art does not teach the structure of claim 5, and thus since the Applicant has amended claim 1 to include the limitations of claim 5, claim 1 is now allowed.

***Response to Arguments***

Applicant's arguments filed 05-22-06 have been fully considered but they are not persuasive.

Applicant argues the Obvious Double Patenting (ODP) rejections, alleging one would not have been motivated to remove the doped metal oxide filler from the polyamide, or teach the structure of cancelled claim 5. Applicant has not made a persuasive argument because the instant claims are broad enough to encompass that which is already claimed in the patents and application referenced above. The instant claims do not exclude the metal oxide, fillers, or other ingredients. The dependent claims actually recite the same metal oxide that's claimed in the patents and application. Schlueter '156 recites the exact same structure of cancelled claim 5. The instant application '452 also recites the exact same alcohol-soluble polyamide adhesive See MPEP 804. The rejection is sustained until terminal disclaimers are submitted to obviate the above three ODP rejections.

***Conclusion***

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

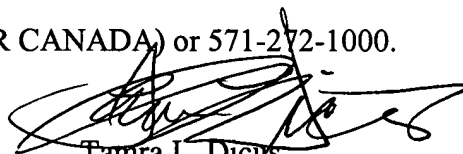
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tamra L. Dicus  
Examiner  
Art Unit 1774

July 19, 2006



PAMELA R. SCHWARTZ  
PRIMARY EXAMINER  
AU 1774